

DOCKET NO: 278485US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROYUKI KURIMURA, ET AL. : EXAMINER: MULLIS, JEFFREY C.
SERIAL NO: 10/549,574 :
FILED: SEPTEMBER 19, 2005 : GROUP ART UNIT: 1796
FOR: LINEAR BLOCK COPOLYMER :
COMPOSITION :

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Examiner's Answer dated May 7, 2009, please consider the following remarks.

Applicants acknowledge with thanks the Examiner's indication that the rejection over Moczygembe 569 is withdrawn.

With respect to the rejection under 35 U.S.C. §102(b) or §103(a) over Moczygembe 838, claim 1 requires, *inter alia*, a block copolymer given by the formula SBS, where B is a block consisting of conjugated diene monomer units. That is, claim 1 requires a conjugated diene homopolymer block surrounded by two vinyl aromatic hydrocarbon blocks.

As discussed previously, each of the polymers according to the invention of Moczygembe 838 is obtained by repeated charges of styrene or styrene/butadiene, followed by a final charge of pure butadiene. *See, e.g., Moczygembe 838*, Table VI. As a result, the inventive polymers of Moczygembe 838 include a terminal polybutadiene block or two central polybutadiene blocks separated by a coupling agent. *See, e.g., Moczygembe 838*,

Table VII. In no case does the inventive polymer of Moczygembe 838 include a conjugated diene homopolymer block surrounded by two vinyl aromatic hydrocarbon blocks.

In the Examiner's Answer, the Examiner asserts that the copolymer composition of claim 1 is not patentable over the polymers shown in Table VIII of Moczygembe 838. See Examiner's Answer, page 5. At the outset, Applicants note that the Examiner is now relying on Comparative Examples of Moczygembe 838 – the polymers of Table VIII of are outside of the scope of the invention of Moczygembe 838. Further, Moczygembe 838 demonstrates that the comparative polymers of Table 8 are inferior to the inventive polymers of Moczygembe 838. See Moczygembe 838, Table XIII. Thus, Moczygembe 838 certainly does not suggest employing the polymers of Table 8 and, more accurately, appears to teach away from using such polymers. The teachings of Moczygembe 838 would not have led a skilled artisan to employ the polymers of the Comparative Examples with a reasonable expectation of success. A *prima facie* case of obviousness cannot be made on the basis of the Comparative Examples of Moczygembe 838.

While it would be legally permissible to argue that the Comparative Examples of Moczygembe 838 anticipate claim 1, the Examiner has simply not provided a basis for concluding that the polymers of the Comparative Examples of Moczygembe 838 would satisfy claim 1. Moczygembe 838 does not indicate that the comparative polymers have the molecular weight features of claim 1. Moreover, it is apparent from the Examples of the present specification that SBS block copolymers may have molecular weight characteristics that fall within or outside the scope of claim 1. See, e.g., present specification, Table 6. That is, SBS block copolymers do not necessarily have the molecular weight characteristics recited in claim 1. It is plain that "[t]he fact that certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of the result or characteristic." See MPEP §2112.IV (citing *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993))

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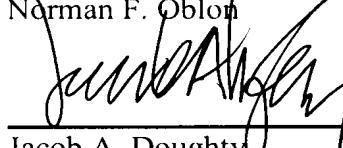
(emphasis in original). Moczygembe 838 does not explicitly disclose that the comparative polymers have the molecular weight features of claim 1, and the Examiner has not provided any basis for concluding that the comparative polymers of Moczygembe 838 inherently have the molecular weight features of claim 1.

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In view of the foregoing remarks and the remarks set forth in the Appeal Brief dated January 29, 2009, Appellants respectfully request that the outstanding rejections be reversed.

Respectfully submitted,

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